



DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Agency Information Collection Activities; Submission to the Office of Management and Budget (OMB) for Review and Approval; Comment Request; Patent Review and Derivation Proceedings

AGENCY: United States Patent and Trademark Office, Department of Commerce.

ACTION: Notice of information collection; request for comment.

SUMMARY: The United States Patent and Trademark Office (USPTO), as required by the Paperwork Reduction Act of 1995, invites comments on the extension and revision of an existing information collection: 0651-0069 (Patent Review and Derivation Proceedings). The purpose of this notice is to allow 60 days for public comment preceding submission of the information collection to OMB.

DATES: To ensure consideration, comments regarding this information collection must be received on or before [INSERT DATE 60 DAYS AFTER THE DATE OF PUBLICATION IN THE FEDERAL REGISTER].

ADDRESSES: Interested persons are invited to submit written comments by any of the following methods. Do not submit Confidential Business Information or otherwise sensitive or protected information.

- *Email:* InformationCollection@uspto.gov. Include “0651-0069 comment” in the subject line of the message.
- *Federal Rulemaking Portal:* <http://www.regulations.gov>.
- *Mail:* Kimberly Hardy, Office of the Chief Administrative Officer, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450

FOR FURTHER INFORMATION CONTACT: Requests for additional information should be directed to Michael P. Tierney, Vice Chief Administrative Patent Judge, Patent Trial and Appeals Board, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450; by telephone at 571-272-4676; or by email to Michael.Tierney@uspto.gov with “0651-0069 comment” in the subject line. Additional information about this information collection is also available at <http://www.reginfo.gov> under “Information Collection Review.”

SUPPLEMENTARY INFORMATION:

I. Abstract

The Leahy-Smith America Invents Act, which was enacted into law on September 16, 2011, provided for many changes to the procedures of the Patent Trial and Appeal Board (“PTAB” or “Board”, formerly the Board of Patent Appeals and Interferences) procedures. These changes included the introduction of *inter partes* review, post-grant review, derivation proceedings, and the transitional program for covered business method patents. Under these administrative trial proceedings, third parties may file a petition with the PTAB challenging the validity of issued patents, with each proceeding having different requirements regarding timing restrictions, grounds for challenging validity, and who may request review.

Inter partes review is a trial proceeding conducted at the Board to review the patentability of one or more claims in a patent only on a ground that could be raised under §§ 102 or 103, and only on the basis of prior art consisting of patents or printed publications. Post grant review is a trial proceeding conducted at the Board to review the patentability of one or more claims in a patent on any ground that could be raised under § 282(b)(2) or (3). A derivation proceeding is a trial proceeding conducted at the Board to determine whether (1) an inventor named in an earlier application derived the claimed invention from an inventor named in the petitioner's application, and (2) the earlier application claiming such invention was filed without authorization. The transitional program for covered business method patents is a trial proceeding conducted at the Board to review the patentability of one or more claims in a covered business method patent. The covered business method program expired on September 16, 2020 and the Board no longer accepts new petitions related to this program, but continues to accept papers in previously-instituted proceedings.

This information collection covers information submitted by the public to petition the Board to initiate an *inter partes* review, post-grant review, derivation proceeding, and the transitional program for covered business method patents, as well as any responses to such petitions, and the filing of any motions, replies, oppositions, and other actions, after a review/proceeding has been instituted.

II. Method of Collection

Applicants submit the information electronically using the PTAB End-to-End (PTAB E2E) filing system. Parties may seek authorization to submit a filing by means other than electronic filing pursuant to 42 CFR 42.6(b)(2).

III. Data

OMB Control Number: 0651–0069.

Form Numbers: None.

Type of Review: Extension and revision of a currently approved information collection.

Affected Public: Private sector; individuals or households.

Estimated Number of Respondents: 9,138 respondents per year.

Estimated Number of Responses: 12,238 responses per year.

Estimated Time per Response: The USPTO estimates that the responses in this information collection will take the public between 30 minutes (0.5 hours) and 165 hours to complete. This includes the time to gather the necessary information, create the document, and submit the completed request to the USPTO.

Estimated Total Annual Respondent Burden Hours: 1,360,058 hours.

Estimated Total Annual Respondent (Hourly) Cost Burden: \$591,625,230.

Table 1: Burden Hour/Burden Cost to Private Sector Respondents

Item No.	Item	Estimated Annual Respondents	Responses per Respondent	Estimated Annual Responses	Estimated Time For Response (hours)	Estimated Burden (hour/year)	Rate ¹ (\$/hour)	Estimated Annual Respondent Cost Burden
		(a)	(b)	(a) x (b) = (c)	(d)	(c) x (d) = (e)	(f)	(e) x (f) = (g)
1	Petition for <i>Inter Partes</i> Review	1,450	1	1,450	124	179,800	\$435	\$78,213,000
2	Petition for Post-Grant Review or Covered Business Method Patent Review	100	1	100	165	16,500	\$435	\$7,177,500
3	Petition for Derivation	10	1	10	165	1,650	\$435	\$717,750
4	Patent Owner Preliminary Response to Petition for Initial <i>Inter Partes</i> Review	1,175	1	1,175	91	106,925	\$435	\$46,512,375
5	Patent Owner Preliminary Response to Petition for Initial Post-Grant Review or Covered Business Method Patent Review	100	1	100	91	9,100	\$435	\$3,958,500

¹ 2021 Report of the Economic Survey, published by the Committee on Economics of Legal Practice of the American Intellectual Property Law Association (AIPLA); pg. F-27. The USPTO uses the average billing rate for intellectual property attorneys in private firms which is \$435 per hour.

6	Request for Rehearing	250	1	250	80	20,000	\$435	\$8,700,000
7	Other Motions, Replies, Surreplies, and Oppositions in <i>Inter Partes</i> Review	2,900	2	5,800	158	916,400	\$435	\$398,634,000
8	Other Motions, Replies, Surreplies, and Oppositions in Post-Grant Review or Covered Business Method Review	200	2	400	148	59,200	\$435	\$25,752,000
9	Other Motions, Replies, Surreplies, and Oppositions in Derivation Proceedings	10	1	10	120	1,200	\$435	\$522,000
10	Pro Hac Vice Admission Motion	950	1	950	0.5 (30 minutes)	475	\$435	\$206,625
11	Request for Oral Hearing	575	1	575	2	1,150	\$435	\$500,250
12	Request to Treat a Settlement as Business Confidential	450	1	450	2	900	\$435	\$391,500
13	Settlement	450	1	450	100	45,000	\$435	\$19,575,000
14	Arbitration Agreement and Award	1	1	1	4	4	\$435	\$1,740
15	Request to Make a Settlement Agreement Available	1	1	1	1	1	\$435	\$435
16	Notice of Judicial Review of a Board Decision (e.g. Notice of Appeal Under 35 U.S.C. §142)	500	1	500	1	500	\$435	\$217,500
	Total	9,222		12,222		1,358,805		\$591,080,175

Table 2: Burden Hour/Burden Cost to Individuals or Households Respondents

Item No.	Item	Estimated Annual Respondents	Responses per Respondent	Estimated Annual Responses	Estimated Time For Response (hours)	Estimated Burden (hour/year)	Rate ² (\$/hour)	Estimated Annual Respondent Cost Burden
		(a)	(b)	(a) x (b) = (c)	(d)	(c) x (d) = (e)	(f)	(e) x (f) = (g)
1	Petition for <i>Inter Partes</i> Review	1	1	1	124	124	\$435	\$53,940
2	Petition for Post-Grant Review or Covered Business Method Patent Review	1	1	1	165	165	\$435	\$71,775
3	Petition for Derivation	1	1	1	165	165	\$435	\$71,775
4	Patent Owner Preliminary Response to Petition for Initial <i>Inter Partes</i> Review	1	1	1	91	91	\$435	\$39,585
5	Patent Owner Preliminary Response to Petition for Initial Post-Grant Review or Covered Business Method Patent Review	1	1	1	91	91	\$435	\$39,585
6	Request for Rehearing	1	1	1	80	80	\$435	\$34,800
7	Other Motions, Replies, Surreplies, and Oppositions in <i>Inter Partes</i> Review	1	1	1	158	158	\$435	\$68,730
8	Other Motions, Replies, Surreplies, and Oppositions in Post-Grant Review or Covered Business Method Review	1	1	1	148	148	\$435	\$64,380
9	Other Motions,	1	1	1	120	120	\$435	\$52,200

² 2021 Report of the Economic Survey, published by the Committee on Economics of Legal Practice of the American Intellectual Property Law Association (AIPLA); pg. F-27. The USPTO uses the average billing rate for intellectual property attorneys in private firms which is \$435 per hour.

	Replies, Surreplies, and Oppositions in Derivation Proceedings							
10	Pro Hac Vice Motion	1	1	1	0.5 (30 minutes)	1	\$435	\$435
11	Request for Oral Hearing	1	1	1	2	2	\$435	\$870
12	Request to Treat a Settlement as Business Confidential	1	1	1	2	2	\$435	\$870
13	Settlement	1	1	1	100	100	\$435	\$43,500
14	Arbitration Agreement and Award	1	1	1	4	4	\$435	\$1,740
15	Request to Make a Settlement Agreement Available	1	1	1	1	1	\$435	\$435
16	Notice of Judicial Review of a Board Decision (e.g. Notice of Appeal Under 35 U.S.C. §142)	1	1	1	1	1	\$435	\$435
	Total	16		16		1,253		\$545,055

Estimated Total Annual Respondent (Non-hourly) Cost Burden: \$69,638,370. There are no capital start-up, maintenance, or postage associated with this information collection. However, this information collection does have annual (non-hour) costs in the form of filing fees which are listed in the table below.

Table 3: Filing Fees (Non-Hour) Cost Burden Patent Review and Derivation Proceedings

Item No.	Item	Estimated Annual Responses (a)	Filing Fee (\$) (d)	Estimated Cost Burden (\$) (a) x (b) = (c)
1	<i>Inter Partes</i> Review Request Fee – Up to 20 Claims	1,450	\$19,000	\$27,550,000
1	<i>Inter Partes</i> Post-Institution Fee – Up to 20 Claims	1,450	\$22,500	\$32,625,000
1	<i>Inter Partes</i> Review Request of Each Claim in Excess of 20	3,500	\$375	\$1,312,500
1	<i>Inter Partes</i> Post-Institution Request of Each Claim in Excess of 20	3,500	\$750	\$2,625,000

2	Post-Grant or Covered Business Method Review Request Fee – Up to 20 Claims	100	\$20,000	\$2,000,000
2	Post-Grant or Covered Business Method Review Post-Institution Fee – Up to 20 Claims	100	\$27,500	\$2,750,000
2	Post-Grant or Covered Business Method Review Request of Each Claim in Excess of 20	350	\$475	\$166,250
2	Post-Grant or Covered Business Method Review Post-Institution Fee of Each Claim in Excess of 20	350	\$1,050	\$367,500
3	Petition for Derivation	10	\$420	\$4,200
10	Pro Hac Vice Admission Fee	950	\$250	\$237,500
14	Request to Make a Settlement Agreement Available	1	\$420	\$420
	Total			\$69,638,370

Respondent's Obligation: Required to obtain or retain benefits.

Request for Comments

The USPTO is soliciting public comments to:

- a) Evaluate whether the collection of information is necessary for the proper performance of the functions of the Agency, including whether the information shall have practical utility;
- b) Evaluate the accuracy of the Agency's estimate of the burden of the collection of information, including the validity of the methodology and assumptions used;
- c) Enhance the quality, utility, and clarity of the information to be collected; and
- d) Minimize the burden of the collection on those who are to respond, including through the use of appropriate automated, electronic, mechanical, or other technological collection techniques or other forms of information technology, e.g., permitting electronic submission of responses.

All comments submitted in response to this notice are a matter of public record. USPTO will include or summarize each comment in the request to OMB to approve this information collection. Before including an address, phone number, email address, or other personally identifiable information (PII) in a comment, be aware that the entire

comment— including PII—may be made publicly available at any time. While you may ask in your comment to withhold PII from public view, USPTO cannot guarantee that it will be able to do so.

Kimberly Hardy,
Information Collections Officer,
Office of the Chief Administrative Officer,
United States Patent and Trademark Office.

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